

REMARKS

In the Office Action dated February 27, 2006, claims 1 and 4-20 were presented for examination. Claims 1, 6, and 11 were rejected under 35 U.S.C. §112, second paragraph. Claims 1 and 4-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Wright*, U.S. Publication No. 2001/0027449 in view of a non-patent referenced titled “Dialog’s Dial Units: A Price Increase in Sheep’s Clothing”, hereinafter referred to as *Dialog*.

The following remarks are provided in support of the pending claims and responsive to the Office Action of February 27, 2006 for the pending application.

I. Rejection of Claims 1, 6, and 11 under 35 U.S.C. §112, second paragraph

In the Office Action of February 27, 2006, the Examiner assigned to the application rejected claims 1, 6, and 11 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which Applicants regard as the invention. More specifically, the Examiner raised an issue with the language amended into the claims in response to the prior Office Action. Applicant has amended the claims herein to remove this amended language and to place the claims into the condition they were prior to submission of the amendment on December 14, 2005. Although the outstanding Office Action is Final, Applicant respectfully requests entry of the amendment as it does not raise any new issues that would require further consideration and/or search since this amendment of the claims merely removes the added language presented on December 14, 2005. Accordingly, Applicant respectfully requests entry of the amendment and removal of the rejection of claims 1, 6, and 11 under 35 U.S.C. §112, second paragraph.

II. Rejection of Claims 1 and 4-20

In the Office Action of February 27, 2006, the Examiner assigned to the application rejected claims 1 and 4-20 under 35 U.S.C. §103(a) as being unpatentable over *Wright* in view of *Dialog*.

Applicants' remarks pertaining to *Wright* and *Dialog* in the Response filed on December 14, 2005 and the response filed in conjunction with the RCE are hereby incorporated by reference.

It is accepted that for a rejection under 35 U.S.C. § 103(a) to stand, there must be a suggestion or motivation in the references themselves to modify the reference or combine the teachings. See MPEP § 2143. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure". MPEP § 2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As noted by the Examiner, *Wright* '449 fails to teach "the weight score assigned to the function prior to the use of the function." Office Action of September 14, 2005, page 3. The Examiner has brought in the *Dialog* article to support this missing element in the *Wright* '449 publication and claimed by Applicant.

Applicant contends that there is no motivation in the prior art references for combining *Wright* '449 and *Dialog*. Rather, the motivation for such a combinations stems from the language in Applicants' claims. Clearly, *Wright* '449 is the primary reference and *Dialog* is the secondary reference being applied by the Examiner. *Wright* '449 teaches dynamically changing the rate associated with a webserver function after the webserver function has been accessed. As such, *Wright* '449 does not provide a user of the webserver function with advanced knowledge of the cost of the access since the rate is not pre-assigned. There is no teaching or suggestion in *Wright* '449 to modify their invention for pre-assigning a rate to a webserver function, as the invention of *Wright* '449 focuses on the dynamic element of the rate assignment. To modify the teaching of *Wright* '449 for the pre-assignment rate structure as claimed by Applicants would go against the teaching of *Wright* '449. Applicants' invention focuses in the inverse principal of rate assignments for webserver functions.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re*

Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

MPEP §2143.01. Similarly, the suggested combination of *Wright* '449 and *Dialog* would require a substantial reconstruction and redesign of the computer implemented instructions in *Wright* '449 for charging a client for webserver function utilization. *Wright* '449 does not contemplate billing a user for accessing a webserver function in the manner claimed by Applicant.

It is clear that the Examiner is taking the elements of Applicant's pending claims and combining them in an improper manner. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). Yet that is the very process that the Examiner has attempted to undertake. Most patents may be considered combination patents in which different elements are combined from prior art to achieve a new and useful apparatus and/or method. Although Applicant's invention may appear to combine elements found in different prior art disclosures, the motivation to combine the references must be in the prior art not in Applicant's pending claims. There is no motivation in the prior art to combine the reference, since such a combination would go against the teaching of *Wright* '449.

It is well settled that each statement of obviousness for the purpose of combining each of the numerous references of record must be found and suggested in the references themselves and not only in the fertile mind of the Examiner. The conclusionary statements of the Examiner must be based upon specific evidence, suggestions and findings in the references of record relied upon

by the Examiner in the rejection of the claimed subject matter. It is respectfully submitted that the record before us lacks any valid reasons to combine the references in the manner done so by the Examiner and contains unsupported reasoning suggested by the Examiner. The Examiner has not established a prima facie case of obviousness with respect to the aforesaid set of claims, there being no motivation to combine the references other than that disclosed in the Applicant's specification. "The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references". *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). It is respectfully suggested that this rejection which contains neither teachings nor motivation to combine the references is without merit and must be withdrawn. Accordingly, Applicant respectfully contends that the combination of *Wright* '449 with *Dialog* does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests removal of the rejection of claims 1 and 4-20 under 35 U.S.C. §103(a).

III. Conclusion

Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicants request that the Examiner indicate allowability of claims 1 and 4-20, and that the application pass to issue. If the Examiner believes, for any reason, that personal communication will expedite prosecution of the application, the Examiner is hereby invited to telephone the undersigned at the number provided.

In light of the foregoing amendments and remarks, all of the claims now presented are in condition for allowance, and Applicants respectfully request that the outstanding rejections be withdrawn and this application be passed to issue.

Respectfully submitted,

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